UNITED STATES PATENT AND TRADEMARK OFFICE

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EXAMINER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _09 July 2007_.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-8 and 10-17_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-8 and 10-17_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _25 June 2003 and 09 July 2007_ is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All   b)☐ Some * c)☐ None of:

      1.☒ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____ .

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____ .

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application
6)☐ Other: _____ .

DETAILED ACTION

Response to Arguments

1.   Applicant's arguments filed July 9, 2007 have been fully considered but they are

not persuasive.

        The Applicant argues on page 10, lines 14-17 that Proehl fails to disclose

that the main data is rendered in normal playback mode after the sub data is

skipped over and that the video data of the substitute information superimposed

upon the main data cannot be incorporated into the main data by being

substituted for the skipped over sub data. The Examiner respectfully disagrees.

Proehl discloses metadata that includes watermark data corresponding to the

primary content data and instructions for displaying the watermark data during a

modified mode, such as a fast playback. Proehl also discloses the watermark

data can be any information that a program producer or advertiser wishes to be

displayed when the program is played in the modified playback mode.

Furthermore, Proehl discloses the watermark can be displayed in any manner,

such as by superimposing the watermark over the primary program content (Fig.

3E; col. 1, lines 38-50). Therefore, Proehl meets the claim limitations and the

rejection is maintained.

Claim Rejections - 35 USC § 103

2.   The text of those sections of Title 35, U.S. Code not included in this action can

be found in a prior Office action.

3.   Claims 1-8 and 10-17 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Thomas et al. (U.S. Patent Application Publication 2003/0037068) in view of Proehl

(U.S. Patent 6,614,844)

Regarding claim **1**, Thomas et al. discloses a video recording/playback

system for recording and playback of video data received, comprising: storage

means (46) which receives and stores video data which consists of sets of main

data and sub data falling under different categories, the sets of main data and

sub data being associated and sequenced along a time axis (Fig. 1, paragraphs

[0024], [0027], [0030], [0044], and [0073] – television programs (main data) along

with advertisements (sub data) are being sent to the system); playback means

which reads main data and sub data from the storage means and renders video

contents of these data (Fig. 9, paragraphs [0071] – [0073], and [0078]), and

control means that judges whether or not the main data has been paused or fast-

forwarded and follows the media data accordingly (paragraphs [0027]).

However, Thomas et al. fails to disclose a control means which judges whether

the sub data has been read from the storage means and its video rendered and,

unless the sub data video has been rendered, changes substitute data which has

been associated in advance with the sub data and embedded in the main data

into video data and when the main data is rendered incorporates the substitute

data into the main data and makes the video data associated with substitute data

render.

Referring to the Proehl reference, Proehl discloses a system comprising:

playback means for reading main data and sub data and rendering video

contents of these data (col. 1, lines 33-53); and control means which judges

whether the sub data has been read from the storage means and its video

rendered and, unless the sub data video has been rendered, changes substitute

data which has been associated in advance with the sub data and embedded in

the main data into video data and when the main data is rendered incorporates

the substitute data into the main data and makes the video data associated with

substitute data render (Fig. 3E; col. 1, lines 38-50; col. 2, lines 32-57).

Therefore, it would have been obvious to one of ordinary skill in the art at

the time the invention was made to have not only added special instructions

during pause modes to display certain images as disclosed by Thomas et al. but

to have added special instructions regarding fast-forwarding that allows the user

to display extra information as disclosed by Proehl in the device disclosed by

Thomas et al. in order to allow advertisers to still promote their product or service

even though their commercial is being fast-forwarded.

Regarding claim **2**, Thomas et al. in view of Proehl discloses all the

limitations as previously discussed with respect to claim 1 including that the main

data is program data and the sub data is commercial data (Thomas et al.:

paragraphs [0024], [0027], [0030], [0044], and [0073] – television programs (main

data) along with advertisements (sub data) are being sent to the system; Proehl:

Fig. 3; col. 2, lines 61-65; col. 3, lines 1-3).

Regarding claim **3**, Thomas et al. in view of Proehl discloses all the limitations as previously discussed with respect to claims 1 and 2 including that the main data and the sub data include an ID code with identifies the set of main data and sub data and attribute data and the control means judges by detected ID code and attribute data whether the sub data has been rendered (Proehl: Fig. 2 – header information; col. 2, lines 31-57 – the metadata includes all necessary information regarding the way content is displayed on the screen).

Regarding claim **4**, Thomas et al. in view of Proehl discloses all the limitations as previously discussed with respect to claims 1-3 including that unless sub data with a same ID code is assigned to main data which is being rendered has been read from the storage means and rendered, the control means changes substitute data which has been associated in advance with the sub data and embedded in the main data into video data and when the main data is rendered incorporates the substitute data into the main data and makes video data accompanied with substitute information render (Proehl: Figs. 3B, 3C, and 3E; col. 1, lines 38-50; col. 3, lines 1-3).

Regarding claim **5**, Thomas et al. in view of Proehl discloses all the limitations as previously discussed with respect to claims 1-4 including that the ID code and the attribute data are embedded in the main data and sub data (Proehl: col. 2, lines 32-57).

Regarding claim **6**, Thomas et al. in view of Proehl discloses all the limitations as previously discussed with respect to claims 1-5 including that the

main data includes substitute information rendering limit data for setting a limit to rendering the substitute data (Proehl: col. 2, lines 32-57 – the embedded data is only displayed for a certain time and not throughout the rest of the program).

Regarding claim **7**, Thomas et al. in view of Proehl discloses all the limitations as previously discussed with respect to claims 1-6 including that the substitute information rendering limit data is specified so that the substitute information will be rendered in a certain range of frames of the main data associated with the sub data which has not been rendered (Proehl: col. 2, lines 32-57 – the embedded data is only displayed for a certain time and not throughout the rest of the program; col. 3, lines 16-23 - the metadata includes the instructions on how and when the watermark data is to be displayed).

Regarding claim **8**, Thomas et al. in view of Proehl discloses all the limitations as previously discussed with respect to claims 1-6 including that wherein, as the substitute information rendering limit data, the number of times the substitute information is to be rendered or a time range within which the substitute information is to be rendered are set (Proehl: col. 2, lines 32-57 – the embedded data is only displayed for a certain time and not throughout the rest of the program; col. 3, lines 16-23 - the metadata includes the instructions on how and when the watermark data is to be displayed).

Regarding claim **10**, Thomas et al. in view of Proehl discloses all the limitations as previously discussed with respect to claim 1 including that the main data includes a substitute data address instead of the substitute data, the

substitute data address specifying where the substitute data has been stored in advance on the storage means or another storage means on a network (Thomas et al: paragraph [0025] – media distribution facility and media data database).

Regarding claim **11**, Thomas et al. in view of Proehl discloses all the limitations as previously discussed with respect to claim 1 including that the input of a cancel code for disabling the rendering of the substitute information makes it impossible for the control means to incorporate the substitute data into the main data and render main video accompanied with substitute information (Thomas et al: Figs. 7 and 8; paragraphs [0071] – [0077]).

Regarding claim **12**, Thomas et al. in view of Proehl discloses all the limitations as previously discussed with respect to claim 1 including that the substitute information is the name of an advertiser, a corporate logo, or a commodity name to advertise which substitutes for the main data (Proehl: Figs. 3D-3F).

Regarding claims **13-17**, these are method claims corresponding to the apparatus claims 1-5. Therefore, claims 12-17 are analyzed and rejected as previously discussed with respect to claims 1-5.

Conclusion

4.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Heather R. Jones whose telephone number is 571-272-

7368. The examiner can normally be reached on Mon. - Thurs.: 7:00 am - 4:30 pm, and

every other Fri.: 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, John Miller can be reached on 571-272-7353. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Heather R Jones
Examiner
Art Unit 2621

HRJ
September 17, 2007

JOHN MILLER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600